UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,857	03/08/2004	Andreas Schuch	032301.371	1268

25461 7590 01/30/2007

SMITH, GAMBRELL & RUSSELL
SUITE 3100, PROMENADE II
1230 PEACHTREE STREET, N.E.
ATLANTA, GA 30307-3592

EXAMINER	
HENDRICKSON, STUART L	
ART UNIT	**PAPER NUMBER**
1754	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/795,857	SCHUCH ET AL.	
	Examiner	Art Unit	
	Stuart Hendrickson	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *1 and 12-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-11, 18-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-21* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The RCE filed is accepted.

1. **Claims 2-4, 8, 10, 18, & 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klasen et al. (US 5,480,626) in view of Bush (US 5,236,992).

Klasen et al. teaches carbon black pellets that have a hardness of 10-50 grams (Claim 7d), an average diameter between 0.5 and 4 mm and a suitable diameter range (Claim 7a-b), and pre-dried moisture contents of 43-52% (Table 1).

Bush teaches carbon black pellets having a DBP of >100, a CDBP of >78, and a surface area of <70 m^2/g (Table 3), and rubber compositions for making hoses and belts.

Klasen states that carbon blacks with properties in the range of 40-450 DBP and surface areas of 30-1200 are suitable for the disclosed pelletizing process. It therefore would have been obvious to someone of ordinary skill in the art to use the carbon blacks taught by Bush in the process taught by Klasen in order to achieve a carbon black pellet with specific properties. The intrinsic properties of the carbon black of Bush can be used to create a pellet with the extrinsic properties taught by Klasen in order to create a pellet with good flowability and dispersability.

When the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference. See MPEP § 2113.

2. **Claims 5-7, 9, 11, 19, & 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klasen et al. (US 5,480,626) in view of Vogler et al. (US 6,231,624).

Klasen et al. teaches carbon black pellets that have a hardness of 10-50 grams (Claim 7d), an average diameter between 0.5 and 4 mm and a suitable diameter range (Claim 7a-b), and pre-dried moisture contents of 43-52% (Table 1).

Vogler et al. teaches carbon black pellets having a DBP of 46, a CDBP of 44, and a surface area of 45 m^2/g (Table 1, CB 5). Vogler teaches a hardness and average particle size slightly lower than claimed.

Klasen states that carbon blacks with properties in the range of 40-450 DBP and surface areas of 30-1200 are suitable for the disclosed pelletizing process. It therefore would have been obvious to someone of ordinary skill in the art to use the carbon blacks taught by Vogler in the process taught by Klasen in order to achieve a carbon black pellet with specific properties. The

intrinsic properties of the carbon black of Vogler can be used to create a pellet with the extrinsic properties taught by Klasen in order to create a pellet with good flowability and dispersability.

Claims 9, 11, 19, & 21: Vogler and Klasen teach the use of carbon black pellets in rubber compositions. It is well known in the art to use such rubber compositions in articles such as tires, belts, and hoses.

When the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference. See MPEP § 2113.

Response to Arguments

Applicant's arguments filed 11/20/06 have been fully considered but they are not persuasive.

Claims 18-21 should be amended to depend upon an elected claim. Arguments to process steps are not persuasive since product claims are examined. Unexpected results must be demonstrated in a direct comparison to the applied references. The motivation to combine is proper. The response does not adequately explain the graphs presented- the axes are unreadable and the arrows are not explained. Is high pressure good or bad? On pg. 19 it is argued that Volger cannot use pneumatic conveying. Why not, and what does this have to do with the claims? The graph is not precise enough for fine calculations of differences; as the reference is also to Degussa it appears that a direct comparison can readily be made. Previous arguments are incorporated herein.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.

Stuart Hendrickson
examiner Art Unit 1754